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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/046,677	03/24/1998	KIMIKAZU FURUKAWA	614.1889	2428

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EXAMINER

AGDEPPA, HECTOR A

ART UNIT PAPER NUMBER

2642

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

**Application**

09/046,677

**Applicant(s)**

FURUKAWA ET AL.

**Examiner**

Hector A. Agdeppa

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1 – 6, 8 – 13, and 15 - 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manning et al. in view of Rosen et al. and further in view of Bulfer.

Regarding claims 1, 3 – 6, 8 - 10, 12, 13, and 15 – 17, Manning et al. teaches a system and associated method of a parallel connected dialing signal transmission inhibiting device for data transfer over a telephone link, wherein a device may be connected to a telephone for the purpose of inhibiting DTMF signals going through or suppressing those signals to a central office when those DTMF signals are indicative of controls or simply any signal that should not be passed on to the central office for processing. This could include the ability to control various household devices via a standard telephone unit or for programming of the actual phone as for example, speed dial, or even for the purpose of invoking special telephony features on that phone as for example, the above-mentioned speed dial. Manning et al. accomplishes this by teaching a device having therein a tone/signal generator 300 for generating tones to be sent to a central office if so needed, a DTMF/tone detector 210 for detecting when DTMF signals come either from the telephone network and represent an actual call or in the event when Manning et al.'s invention is used for voice messaging, controlling signals or whether they are control signals coming from the telephone unit, a microprocessor 400 and various electrical components for switching between having the

telephone unit connected to a telephone network or not. (Abstract, Figs. 1 – 5B, Col. 1, line 53 – Col. 3, line 35, Col. 4, lines 14 – 50, Col. 7, line 10 – Col. 12, line 12)

What is not taught by Manning et al. is a data processing device being controlled or utilized via a telephone unit for telephony purposes.

However, Rosen et al. teaches communication with a computer using telephones, wherein a device allows DTMF tones from a telephone unit to be used to control telephony communication service or communication software resident on the computer, while allowing communication to and from a telephone network when need be. (Abstract, Figs. 1 – 5, Col. 1, line 26 – Col. 3, line 15, Col. 4, line 4 – Col. 12, line 48, Col. 16, line 1 – Col. 17, line 28)

Manning et al. and Rosen et al. both teach the use of a telephone for controlling a separate appliance, Manning et al. being limited to household appliances or the telephone unit itself. It would have been obvious to have extended the invention of Manning et al. to include controlling telephony services on a computer inasmuch as computers can be considered to be simply another separate household appliance, and as taught by Rosen et al. it is useful to be able to control computers via telephone units for ease of operation, for convenience, remote operation, etc. Albeit that the invention of Rosen et al. functions in a slightly different manner than the invention of Manning et al. with respect to how signals are inhibited and how communication is achieved between computer and telephone, i.e., Rosen et al. teaches the use of voice recognition/commands via the telephone unit whereas Manning et al. teaches the use of DTMF tones for control.

However, it is very well known in the art to convert voice into DTMF tones for specifically the purpose of using voice commands as taught by Bulfer. (Abstract, Fig. 1 and 2, Col. 1, line 13 – Col. 2, line 46, Col. 3, line 10 – Col. 5, line 24) Furthermore, it is very well known in the art that many systems already convert voice into DTMF signals as this was once the only way for voice recognition commands to be implemented and recognized by telephonic systems.

Also not taught explicitly by Manning et al. is codes differing between network sources and telephony units.

However, such would be at the very least obvious if not inherent in most any telecommunications system. Calls from the network will come in to check, for example, voice mail or check messages on an answering machine. In this common scenario, the system MUST be able to differentiate between signals from the network and those from the telephone unit, and such is usually done by having different predetermined values for various DTMF signals, or else the system becomes confused or has interfering feature interactions. Furthermore, Manning et al. contemplates differentiating between various DTMF signals and predefined code designations, as seen in the sections of Manning et al. mentioned above.

Regarding claims 2 and 11, it is inherent or would be very obvious to have a unit or two separate units, as the multiplication of units performing the same function has no inventive function, for the purpose of separating DTMF from voice signals as claimed in the present invention. One simple example is when one would not want to send voice to the microprocessor 400 of Manning et al. when programming it if it is not required.

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Obviously, only the DTMF control signals are necessary. Furthermore, if one were to send voice and DMTF tones simultaneously, a system would either never be able to detect what signals are for control or which actually comprise, for example, a conversation or if it could, it would be counter-intuitive to not separate them as DTMF and voice signals many times have different functions.

### ***Response to Arguments***

2. Applicant's arguments filed 10/10/02 have been fully considered but they are not persuasive.

Applicant's arguments seek to distinguish the present invention by arguing that the amended claims which now teach a switch connected in between a telephone network and either a telephone unit or data processing device that inhibits DTMF signal transmission make the present invention patentably different from the prior art.

However, after further consideration, Examiner cannot agree with Applicant's arguments. With respect to the Manning et al. reference, what is taught is a "parallel-connected dialing signal detection and transmission-inhibiting device." See Abstract. The term parallel connected in the Manning et al. reference simply refers to the electrical engineering aspect of the circuitry differentiating it between a serial connection. Here, because a telephone has both a tip and ring line, any like device, even the present invention, would likely have to be connected in "parallel" because the device has an impact on both the tip AND ring lines. To be traditionally "serially" connected, the device would have to be located ONLY on either the tip line OR ring line.

However, what Applicant seems to be claiming is a device that simply resides in between a telephony network and a telephone device. As seen in Fig. 1 of Manning et al., the circuitry in question is in fact located between the telephone network, i.e., the central office (5) and PSTN beyond that AND the telephone devices 1 and 2 (30, 32). Therefore, Manning et al. in fact does read upon the amended limitation. As to the "inhibition" aspect of the present invention, Applicant seems to want to differentiate between the attenuation of Manning et al. and the "inhibition" of the present invention.

However, even though signals are attenuated in Manning et al. and not completely "inhibited," as can be seen in the above reference to the Abstract of Manning et al., that the Manning et al. invention is still described as a "transmission-inhibiting" device. At the very least, making a completely inhibiting device would be obvious over a severely attenuating device which has the same end purpose, that of stopping certain DTMF signals from reaching the telephone network.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

H.A.A.  
December 30, 2002

*Harry S. Hong*

**HARRY S. HONG  
PRIMARY EXAMINER**